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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,593	03/09/2004	Steven R. Hayter	D5407-224	1098

25397 7590 11/13/2006

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HOUSTON, TX 77027

EXAMINER
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GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,593

Applicant(s)

HAYTER ET AL.

Examiner

Jennifer H. Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on October 30<sup>th</sup>, 2006.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-7 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (US 2002/0066573).

*Regarding claim 1:* Patel discloses lock mechanism for a downhole tool. The lock mechanism includes the following features:

- A stationary component **44a, 44b**.
- A final controlled element **22**.
- A movable component **13** movable with respect to said stationary component and linked to the final controlled element to put said final controlled element in at least two positions.
- A lock assembly **206** triggered by a predetermined movement of said movable component that acts to impede movement of said movable component with respect to said stationary component.

*Regarding claim 2:* The lock assembly is automatically triggered when said final controlled element reaches a predetermined position.

*Regarding claim 5:* The lock assembly includes a pair of shoulders that can pass by each other until the predetermined movement is reached whereupon a locking member **215** extends at least one of said shoulders to selectively prevent them from passing each other (see paragraphs [0019], [0020], [0036], and [0037]).

*Regarding claim 6:* The locking member moves relatively to said shoulder that it extends.

*Regarding claim 7:* The locking member comprises at least one collet mounted to the movable member.

*Regarding claim 15:* The lock assembly can be released by relative movement between itself and the shoulder that it had extended as a result of a part of said movable component being released to operate said final controlled element into another of its said two positions.

*Regarding claim 16:* Patel disclose a lock assembly for a downhole valve where the lock assembly includes the following features:

- A stationary housing **44a, 44b**.
- A mandrel **13** movably mounted with respect to said housing and connected to a valve member **22** to selectively open and close said valve member in response to a predetermined movement of said mandrel.
- A lock **206** that automatically engages when said valve member reaches one of said open and closed positions, said valve member selectively moved to the other of said open and closed positions with the lock still engaged.

*Regarding claim 17:* The lock selectively retains said mandrel to said stationary housing.

### ***Allowable Subject Matter***

3. Claims 8-14 and 18-20 are allowed.
4. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

5. In view of applicants' amendment, the 35 USC 112(2) rejection of claims 1-7 and 15 has been withdrawn.
6. Applicant's arguments filed October 16<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

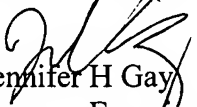
In response to applicant's argument that Patel does not teach a lock assembly that is incapable of being moved by a force or pattern of forces applied thereto, the examiner notes that Patel teaches that element 206 locks to element 13 after a predetermined number of movements of element 13. Patel further teaches that element 206 is not disengaged from element 13 but rather element 13 moves to the 5nal controlled element 22 to a different position.

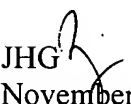
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Mon., Tues., Thurs., and Fri. from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H Gay  
Primary Examiner  
Art Unit 3672

  
JHG  
November 7, 2006